

REMARKS / ARGUMENTS

Summary of Request for Continued Examination

Continued Examination of the present application is respectfully requested. This response to the present Office Action is a bona fide attempt to advance the present application to final action. MPEP 1.111(b). The claims, as amended, are patentably distinguished from the previous references as will be set forth herein. Specifically, the claims as amended bring attention to various distinguishing features of the present invention, in that the present invention is directed to a merchandising strip. The present invention is truly novel in that none of the art disclosed by the references cited, even when taken as a whole, alone or in combination, clearly demonstrate the structural limitations and the interacting combination of elements that is necessary for operation of a merchandising strip. MPEP 1.111(c).

Summary of Amendments to the Claims

Claim 1 is as previously presented.

Claim 2 is original.

Claim 3 is cancelled without prejudice.

Claim 4 is as previously presented.

Claims 5 - 13 are original.

Claims 14 - 21 are cancelled without prejudice.

Claims 22 - 23 are as previously presented.

Claims 24 – 26 are new.

Claim Rejections based 35 USC §103

Claims 1 - 22.

The Office Action rejected claim 1 based on the combination of Repaci and Miles.¹ Repaci is a patent for a “shipping and display system product shipping and display strip system displaying items, or product, at retail store check out counters and high traffic areas.” Miles is a patent for “A method and apparatus for sequentially and precisely registering cut sheets for application onto advertising signatures at high speeds employs an initial roll of sheeting material.”

The Office Action states:

Rodriquez [sic: Repaci] fails to disclose said first side being coated, wherein the coating of said first coated side is substantially non-adhesive to said plurality of adhesive elements, whereby ease in rolling and unrolling said plastic strip along the longitudinal axis is enabled by said coated side and adhesive element combination.

The Office Action also states:

[i]t would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the first side coated with silicone in Rodriquez [sic: Repaci] in order to facilitate the unwinding of the sheeting from a roll as taught by Miles.

“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP 2143.01 IV, citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter.

¹ “Claims 1,2 and 4 -13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repaci et al. (USPN 6,109,852 [sic: 6,109,582]) in view of Miles (USPN 6,383,591).”

1993). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”” MPEP 2143.01 III, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 3988, 418 82 USPQ2d 1385, 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). The Office action provides no explanation of why it would have been obvious to one of ordinary skill in the art to combine the teachings of these two references from disparate fields.

In response to Applicant’s arguments, the Office Action says “there is some teaching, suggestion, or motivation [to combine the references] found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art since Miles shows” coating one side of a strip with silicone to facilitate rolling and unrolling of the strip.

The Office Action does not identify the teaching, suggestion, or motivation to combine these references, or tell us whether it comes from the references themselves or from knowledge generally available to one of ordinary skill in the art. Without this, the Office Action does not provide any articulated reasoning or rational underpinning to support the legal conclusion of obviousness.

The suggestion to combine the references cannot come from *Repaci* since *Repaci* does not mention rolling of the display strip, as acknowledged by the Office Action. Without any teaching or suggestion to roll the display strip in *Repaci*, one of ordinary skill in the art would not know to look to solutions in the field of rolled adhesives. Similarly, the suggestion cannot come from *Miles* because *Miles* does not discuss display strips or rolling of a finished product. Further, *Miles* is not analogous art. “Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed.”” MPEP §2141.01(a), citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1397 (2007). The problem of rolling product display strips longitudinally was not known in the field of Applicant’s

invention, prior to Applicant's invention, as will be discussed more fully below in regards to claim 22. Without any relevance to a problem known in the art at the time of the invention, *Miles* is not analogous art and is not a proper reference for a rejection under section 103.

Claims 2 – 21.

Claims 2 through 21 depend upon Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 22.

The Office Action rejected claim 22 in view of the combination of *Repaci*, *Miles*, and *Miller*. The Office Action states “It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have provided the rolled strips in *Repaci* et al. in order to dispense the display strips as taught by *Miller* et al.” The Office Action also states that “[w]ith regard to the limitation of ‘along the longitudinal axis of the plastic strip’, it would have been obvious to one of ordinary skill in the direction of how the strips are rolled in order how to change how the strips are dispensed.” As with the rejection of claim 1, the Office Action does not identify the teaching, suggestion, or motivation to combine these references, or tell us whether it comes from the references themselves or from the knowledge generally available to one of ordinary skill in the art. Without this, the Office Action does not provide any articulated reasoning or rational underpinning to support the legal conclusion of obviousness. Therefore, the Office Action does not set forth a *prima facie* case of obviousness.

Even if a *prima facie* case of obviousness had been made, the cited references do not teach the device of Claim 22. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie*

obvious.” MPEP §2143.01 VI, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed below, rolling a sheet of plastic strips across the longitudinal axis of those strips is the key principle of operation taught by *Miller*. In this case, modifying *Miller* from having a roll of multiple strips rolled across the longitudinal axis of the strips to one in which the strips themselves were rolled along their longitudinal axis would wholly change the principle of operation of the device taught by *Miller*. Therefore, the Office Action does not make a *prima facie* case of obviousness.

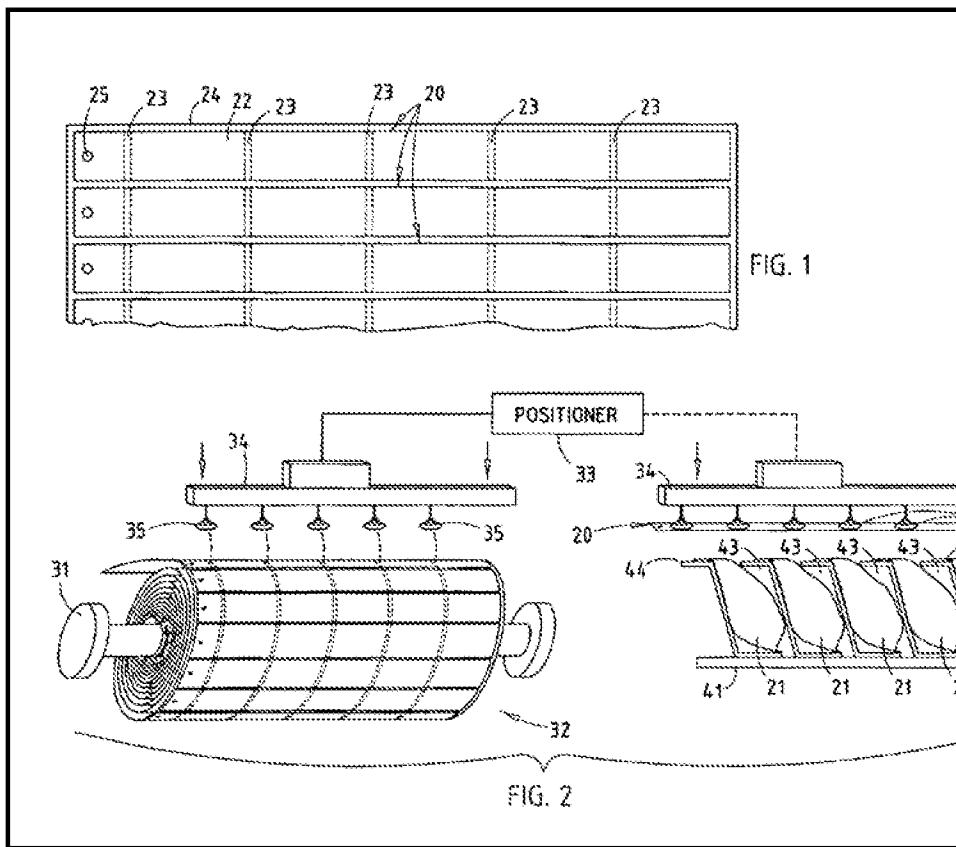
“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP 2141.03 VI, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). “A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” MPEP §2144.05 III, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) (emphasis added). Claim 22 requires that the plastic strip be “positioned and arranged into a rolled state along the longitudinal axis of the plastic strip.” *Miller* does not teach rolling of a plastic strip at all, let alone along its longitudinal axis. In fact *Miller* repeatedly and explicitly teaches away from rolling plastic strips along their longitudinal axis:

This allows the adhesive strips 23 to form a substantially continuous strip of adhesive 23 running parallel the length of the roll, and also allows the display strips 20 to be presented one by one as the roll is unwound a short distance equal to a width of the display strips 20. Due to the short distance of the roll as it is unwound, it allows the display strips 20 to be easily removed one at a time off an end of the roll. Also, the display strips 20 do not take on a longitudinally curved shape along their length, since the display strips 20 are held in a substantially flat condition on the roll 32, as discussed below.

Due to the orientation of the adhesive (i.e. the alignment of the adhesive strips 23 parallel a length of the roll 32 of release paper), the present arrangement lends itself to automated manufacture of the display strips in high volume, and further it conserves the amount of adhesive used since the adhesive only need be applied to the width and spacing desired. Further, the roll 32 is easy to handle, since it is 20 or more inches wide, instead of only 1 to 2 inches wide. Also, since the display strips 20 only

extend an inch or two around the circumference of the roll 32, instead of twenty or more inches around the circumference of the roll, the display strips 20 don't tend to bunch up and/or pull free from the release paper 24.

Since the roll 32 is unwound at a relatively slow rate due to the transverse orientation of the display strips 20 on the roll 32, and since the display strips 20 are presented in a controlled rate, and since the packages 21 and selected display strip 20 are secure and handled in a reliable, repeatable manner, the process can be easily automated with good accuracy and speed.



These passages name at least eight reasons not to roll the plastic strips longitudinally as required in Claim 22. *Miller* specifically names the following advantages of rolling a sheet of plastic strips across their longitudinal axis:

1. allows the adhesive strips 23 to form a substantially continuous strip of adhesive 23 running parallel the length of the roll;

2. and also allows the display strips 20 to be presented one by one as the roll is unwound a short distance;
3. allows the display strips 20 to be easily removed one at a time off an end of the roll;
4. the display strips 20 do not take on a longitudinally curved shape along their length;
5. lends itself to automated manufacture of the display strips in high volume;
6. it conserves the amount of adhesive used since the adhesive only need be applied to the width and spacing desired;
7. the roll 32 is easy to handle, since it is 20 or more inches wide, instead of only 1 to 2 inches wide;
8. the display strips 20 don't tend to bunch up and/or pull free from the release paper 24.

Therefore, *Miller* teaches away from claim 22 and cannot serve as the basis for a rejection of that claim under 35 U.S.C. 103. As such, the Office Action does not show that the device described in claim 22 would have been obvious to one of ordinary skill in the art at the time the invention was made.

Also, Claim 22 depends upon Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 23.

The Office Action deems Claim 23 allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Claim 23 depends upon Claim 22 which depends upon Claim 1 and should be allowable should the Examiner find either Claim 1 or Claim 22 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 24.

Claim 24 is new. Claim 24 incorporates the limitations of Claim 1 along with the further limitation that the pre-shaped adhesive elements be spaced from the longitudinal edges of

the strip. This is disclosed in the original application, as filed, including Figs. 1, 2, 4, 6(b) and 6(c), and page 8, lines 4-8 and 14-17.

The cited prior art references do not disclose the manufacture of a product, or the method of manufacture of a product, having “a plurality of pre-shaped adhesive elements spaced from the longitudinal edges of the strip”.

Miller and Repaci, in particular, do not disclose a strip or method of manufacture capable of producing “adhesive elements spaced from the longitudinal edges of the strip”.

Miller discloses:

“...several spaced-apart transverse adhesive strips 23 **that extend completely across the backing member 22...**”

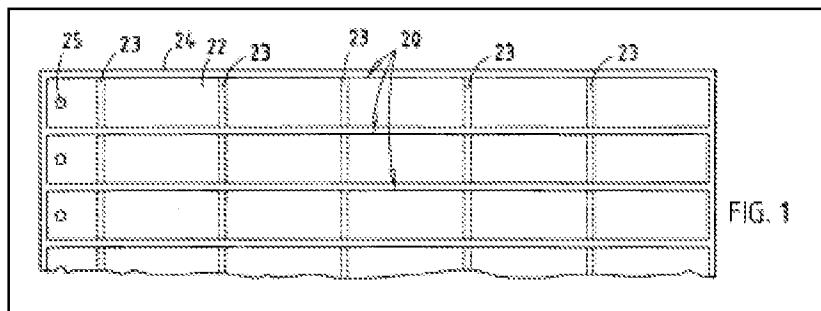


Fig. 1 of Miller shows that the method of manufacture of strip 20 depends upon a continuous deployment of adhesive strips 23 “extending completely across backing member 22”, failing to disclose a method for producing a strip having “adhesive elements spaced from the longitudinal edges of the strip”.

Miller further discloses:

“...and including a plurality of spaced-apart **adhesive strips that extend across each backing member** in a direction parallel to the length of the release paper, the plurality of elongated display strips being positioned in a side-by-side arrangement on the roll with the adhesive strips engaging the release paper and the backing member such that the display strips are presented one at a time as the roll is unwound **a distance about equal to the width of one of the display**

strips, the adhesive strips on each display strip all being completely exposed when the display strips are removed from the roll.”

Miller clearly teaches away from “a plurality of pre-shaped adhesive elements spaced from the longitudinal edges of the strip”.

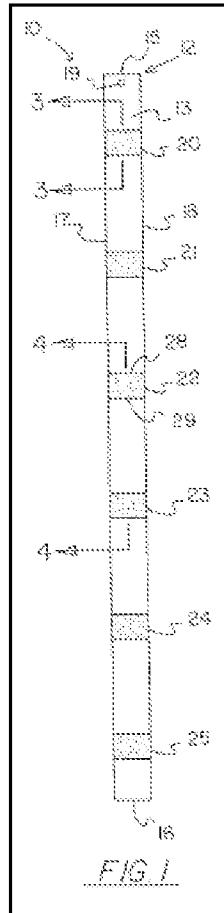
Repaci discloses:

“Preferably, each of the adhesive areas 20-25 is generally rectangular and is extended between the sides 17, 18 of the strip 12 such that each of **the adhesive areas 20-25 has a pair of lateral sides 28, 29 extending between the sides 17, 18 of the strip 12.**”

Repaci further discloses:

“In the ideal illustrative embodiment shown in the Figures, each of the adhesive areas 20-25 has a **width defined between the sides 17, 18 of the strip 12** and a length defined between the lateral sides 28, 29 of their respective adhesive area. Preferably, **the width of each of the adhesive areas 20-25 is substantially equal to the strip 12 width** while the length of each of the adhesive areas 20-25 is less than about 11/4 inches.”

Repaci clearly teaches away from “a plurality of pre-shaped adhesive elements spaced from the longitudinal edges of the strip”.



The references, when combined, do not produce the merchandising strip as claimed; it is not disclosed how to make a merchandising strip having all the limitations as set forth in the claim. *See, In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). *See, MPEP 2143.01(I)*. Further, the references, if combined, would change the principle of operation of the Miller prior art invention. *See, In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *See, MPEP 2143.01(VI)*.

The arguments and remarks as set forth from Claims 1 – 22 also apply for Claim 24.

Claim 24 incorporates the limitations of Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See, MPEP 2143.03.*

Claim 25.

Claim 25 is new and depends upon Claim 24 and should be allowable should the Examiner find Claim 24 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

The arguments and remarks as set forth from Claims 1 – 22 and 24 also apply for Claim 25.

Claim 25 incorporates the limitations of Claim 1 and Claim 22 and should be allowable should the Examiner find either Claim 1 or Claim 22 to be allowable. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See, MPEP 2143.03.*

Claim 26.

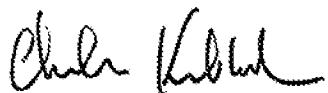
Claim 26 is new and depends upon Claim 25 which depends on and Claim 24 and should be allowable should the Examiner find Claim 24 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03. Further, the Office Action deems Claim 23 allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Claim 26 has all of the limitations of Claim 23 with an additional limitation in its independent base Claim 24. Therefore, Claim 26 should be allowable, at least if re-written in independent form, based on the allowability of Claim 23.

Summary.

For all the above reasons, Applicant submits that the claims are now in proper form for allowance and that the claims all define patentably over the prior art. Therefore applicant submits that this application is now in condition for allowance and favorable action on the merits of this case is respectfully requested.

One independent and two dependent claims were added. It is believed no fees are due regarding claims. Payment of fees for the Request for Continued Examination, 37 CFR 1.17(a)(3), is included with this Response. Payment of fees for Request for Extension of Time is included with this Response. The Commissioner is hereby authorized to charge Deposit Account No. 01-2511 for any fees associated with this application, and to charge any additional filing fees or credit any overpayment to Deposit Account No. 01-2511.

Respectfully Submitted,



Charles Knobloch, J.D., P.G.
Patent Attorney for Applicant